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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/562,880

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Katsuo Shibahara

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EXAMINER

PILKINGTON, JAMES

ART UNIT

PAPER NUMBER

3656

NOTIFICATION DATE

DELIVERY MODE

12/08/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/562,880	Applicant(s) SHIBAHARA, KATSUO	
	Examiner JAMES PILKINGTON	Art Unit 3656	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 November 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) 4 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 November 2009 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>11/24/09</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 2 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 2 recites the limitation "the longitudinal axis" in line 3. There is insufficient antecedent basis for this limitation in the claim. Perhaps this limitation should read - –a longitudinal axis of the housing- -.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Shishido, WO03/027521.

Shishido discloses a fluid bearing device comprising a housing (56); a bearing sleeve (55) disposed inside the housing (56); a shaft member (51) inserted along an inner peripheral surface of the bearing sleeve (55); and a radial bearing portion (58) which supports the shaft member (51) in a non-contact manner in a radial direction via a

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lubricating oil film (57) that is generated within a radial bearing gap between the inner peripheral surface of the bearing sleeve (55) and an outer peripheral surface of the shaft member (51), wherein the housing (56) comprises a cylindrical side portion (61) and a seal portion (63) which forms a continuous integrated unit with the side portion (61, see Figure 46) and extends radially inward from one end of the side portion, the seal portion comprises an inner peripheral surface (65) which forms a sealing space with an opposing outer peripheral surface of the shaft member (at 67), and an outside surface (top surface of 63) which is positioned adjacent to the inner peripheral surface (65) and an outer peripheral edge (corner between 61 and 63) on the outside surface.

Regarding the limitation of the housing being formed by injection molding of a resin material, the outer surface comprising a machined surface formed by machining to remove a res gate portion, and the outside surface of the seal portion is a molded surface except for the machined surface: These limitations are a product-by-process limitation, MPEP 2113 states:

“[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.” *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) (citations omitted) (Claim was

In this case, Shishido discloses all of the claimed structure and therefore meets the limitations of the claim. The method in which the part is formed (i.e. molding and machining) does not alter the claimed structure or define any particular structure.

Claim Rejections - 35 USC § 103

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shishido in view of Fujinaka, US PGPub 2003/0113045.

Shishido does not disclose that the outer peripheral edge ('machined' surface) extends oblique relative to the longitudinal axis or that the outer peripheral edge is annular beveled ring in communication with the inner peripheral surface via the outside surface.

Fujinaka teaches a bearing housing (2) having an outer peripheral edge (see upper portion of Figure 2) that extends oblique relative to the longitudinal axis (of the housing) and that the edge is an annular beveled ring in communication with the inner peripheral via the outside surface (connected to the inner peripheral surface via the outer surface).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Shishido and provide for the outer peripheral edge ('machined' surface) to extend oblique relative to the longitudinal axis or that the outer peripheral edge is annular beveled ring in communication with the inner peripheral surface via the outside surface, as taught by Fujinaka, since it is obvious to a person of

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ordinary skill to pursue known options within their technical grasp. Fujinaka discloses that it is known to add a bevel to the outer housing and the addition of such a bevel to Shishido does not alter the function of the housing and provides the predictable result of reducing material and weight of the final assembly.

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shishido in view of Obara, US PGPub 2003/0202722.

Shishido discloses all of the claimed subject matter as discussed above.

Shishido does not disclose that the outside surface of the seal portion is applied with an oil repellent.

Obara teaches an outer surface of a housing (7) which has an oil repellent (30) applied on the outer surface of the sealing portion (top of housing at 28, see Figure 4a) for the purpose of improving the containment of the lubricating oil (paragraph 0096).

It would have been obvious to one having ordinary skill in the art at the time of the invention to provide the outside surface of the seal portion of Shishido with an oil repellent, as taught by Obara, for the purpose of improving the containment of the lubricating oil.

Double Patenting

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

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A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 1 and 3 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 19 and 21 of copending Application No. 10/548170.

This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

Response to Arguments

Applicant's arguments with respect to claims 2 and 5 have been considered but are moot in view of the new ground(s) of rejection.

Applicant's arguments filed November 24, 2009 have been fully considered but they are not persuasive.

Applicant argues that neither Shishido nor Obara disclose "a machined surface formed by machining to remove a resin gate portion, and the outside surface of the seal portion is a molded surface except for the machined surface" and that this is not a feature of the method of making but a structural feature of the final product.

Machining or molding does not alter the shape of the final component. Flat, angled and curved surfaces can all be made by machining or molding. Without defining the shape of the machined or molded surface in the claim any surface can meet this limitation. Since the claim does not define any particular structure or shape of the machined surface any structure regardless of how it is produced can meet this limitation. Applicant later claims the shape of the "machined" surface to be oblique to

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the longitudinal axis or beveled, but this does not introduce any particular "machining" or "molding" structure since the beveled surface could still be made during a molding process (the mold contains the bevel) or material could be cut or machined off later in production. Regardless of which method is used the final structure remains the same.

Regarding the Applicant's arguments directed toward the double patenting rejection above, the amendment to the claim 1 does not introduce any new structure, see remarks above. Since claim 1 does not introduce any new structure claims 19 and 21 of application 10/548170 recite the same structure of claims 1 and 3 of the instant application.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMES PILKINGTON whose telephone number is (571)272-5052. The examiner can normally be reached on Monday - Friday 7-3.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Ridley can be reached on (571)272-6917. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/JAMES PILKINGTON/
Examiner, Art Unit 3656
12/1/09

/Thomas R. Hannon/
Primary Examiner, Art Unit 3656